

REMARKS

Reconsideration of this RCE, as amended, is respectfully requested.

In the Final Office Action, the Examiner again objects to the specification alleging that the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication, is improper, and that the Applicant is required to amend the disclosure to include the material incorporated by reference.

In the response to the previous Office Action, Applicant responded by stating that the essential material of the priority document is already contained in the specification. However, the Examiner requests that since the essential material is already recited in the application, that Applicant delete the language in the specification allegedly improperly incorporating material from the foreign application.

However, Applicant knows of no authority for such a requirement and the Examiner fails to cite any authority that material cannot be incorporated from a foreign application on which an application claims priority. Therefore, Applicant respectfully requests that the Examiner provide authority for his position in the response to the Final Office Action.

In the Final Office Action, the Examiner rejects Claims 1-13. Claims 1-2, 7 and 13 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,843,387 to Dane et al. (hereinafter "Dane"). Claims 1-13 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,534,221 to Hillebrenner et al. (hereinafter "Hillebrenner").

In response, the Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 102(b) for at least the reasons set forth below. However, independent

claim 1 and the dependent claims, where necessary, have been amended for clarification purposes only and to express what was previously inherent therein.

In the Final Office Action, the Examiner argues with respect to Dane "Figs. 5 and 7 [of Dane] clearly showing the instrument supported within a cushioning structure, not fit therein" and with respect to Hillebrenner "the claims fail to require protect[ion] for all pressing forces, and the structure of Hillebrenner prevents pressing contact between sections of the instrument" (see "Response to Arguments," page 4 of the Final Official Action).

With regard to Dane, the Applicant would like to point out that Figures 5 and 7 show a portion of the container tray where the instrument is not being positively gripped. The Applicant respectfully submits that other portions of the instrument are positively gripped by press fitting into opening 34 as shown in Figure 6. With regard to Hillebrenner, the Examiner is correct in that the clips 252, 254 are used to grasp the endoscope at certain portions while other portions are unsupported.

Therefore, it appears that the Examiner has interpreted the "pressing force preventing means" of claim 1 to require preventing pressing forces from being applied to only a portion of an outer surface of the flexible section while allowing pressing forces to other sections of the flexible section. Such an interpretation of claim 1 is inconsistent with the specification and the objective of the present invention. As discussed in the specification of the present application for endoscopes having a soft insertion section, the press fit will cause a deformation in the outer wall of the insertion portion, which may become permanent after the application of high-pressure, high-temperature steam sterilization. Thus, the vessel for high-temperature high-pressure steam sterilization as recited in claim 1 prevents a concentration of pressing forces from being applied to an outer surface of the flexible section. It would make

little sense and be inconsistent with the objective of the present invention to prevent a concentration of pressing forces in some portions of the flexible section while allowing a concentration of pressing forces in other sections of the flexible section.

Although, the Examiner's interpretation of the "pressing force preventing means" of claim 1 is wholly inconsistent with the specification of the present application, in order to advance prosecution, the Applicant has nonetheless amended claim 1 to recite that the pressing force preventing means prevents pressing forces from being "concentrated and applied to at least one locus portion of an outer surface of the flexible section when accommodated in the accommodating recess section."

The present amendment to the claims is fully supported in the original disclosure, including the Figures. Thus, no new matter has been entered into the disclosure by way of the present amendment.

With regard to the rejections of claims 1-13, under 35 U.S.C. § 102(b), a vessel for high-temperature high-pressure steam sterilization having the features described above and as recited in independent claim 1, are nowhere disclosed in either Dane or Hillebrenner. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by either Dane or Hillebrenner. Accordingly, independent claim 1 patentably distinguishes over both Dane and Hillebrenner and is allowable. Claims 2-13 being dependent upon claim 1 are thus at least allowable therewith.

Still further, the Examiner rejects claims 8 and 10-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10

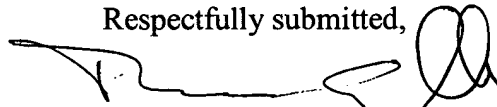
¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

of copending U.S. Application No. 09/919,190. In response, in order to advance prosecution, Applicant files herewith a terminal disclaimer disclaiming any portion of the term of a U.S. patent that eventuates from the present application, which would extend beyond the term of U.S. Application No. 09/919,190.

Furthermore, new claims 16-24 have been added to further define the patentable invention. New claims 16-24 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 16-24. Applicant respectfully submits that new claim 16 is at least allowable as depending upon an allowable base claim (claim 1 and intervening claim 2). Applicant further submits that independent claim 17 patentably distinguishes over the prior art and is allowable and that claims 18-24 are at least allowable as being dependent therefrom.

The above amendments and remarks establish the patentable nature of all the claims currently in this case. Issuance of a Notice of Allowance and passage to issue of these claims are therefore respectfully solicited. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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